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10/635,586	08/06/2003	Allen M. Gilbert	RSW920030087US1 (102)	1393
46320	7590	02/25/2011	EXAMINER	
CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP			BIAGINI, CHRISTOPHER D	
STEVEN M. GREENBERG				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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*Ex parte* ALLEN M. GILBERT, DAVID LOUIS KAMINSKY and  
BALACHANDAR RAJARAMAN

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Appeal No. 2009-006032  
Application 10/635,586  
Technology Center 2400

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DECISION ON PETITION

This is a decision on the “Petition Under 37 C.F.R. § 41.3”, filed December 21, 2010 (“Petition”). The Petition requests that:

1. “that certain rejections be designated a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b)”.

FINDINGS

- 1) On March 26, 2009 a Docketing Notice, giving the application an Appeal Number of 2009-006032 was mailed to appellants.
- 2) On June 9, 2010, the Board mailed a decision to Appellants, which affirmed all the rejections on appeal.
- 3) On August 9, 2010, appellants filed a Request for Rehearing. In their Request, Appellants argued:
  - 1) “the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal

Brief of February 22, 2008 and in the Reply Brief of June 17, 2008”  
(Request for Rehearing p2) and;

b) “If the Honorable Board believes that the present rejection should be maintained, designation as a new ground is necessary because Appellants have not had a fair opportunity to react to the thrust of the ‘affirmance’ of the rejection, which is based upon a characterization of the prior art that was not relied on by the Examiner”. (Request for Rehearing p.8)

- 4) On December 8, 2010, the Board mailed to Appellants a Decision on Rehearing, which denied Appellants’ Request for Rehearing, and also denied Appellants’ Request to designate a new grounds of Rejection.
- 5) Appellants, on December 21, 2010, filed their Petition Under 37 CFR §41.3, requesting that the Chief Administrative Patent Judge designate the new grounds of rejection.

## DISCUSSION

Appellants, in their petition, state that:

The issue of whether or not a decision by the Board constitutes a new grounds of rejection involves the question as to whether the Board followed the regulations of the Patent Office, and a review of this issue is a proper exercise of authority. *See In Re Oku*, 25 USPQ2d 1155 (Comm’r Pat. 1992)”.

The Commissioner (now Director) in *Oku* did not grant *Oku*’s request for a designation of a new grounds of direction. Instead, the Commissioner granted a request to reopen under 37 CFR §1.198, and denied the rest of the

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Petition (*In Re Oku*, 25 USPQ2d 1155, 1157 (Comm'r Pat. 1992)). It is also noted that *In re Weiss* 160 USPQ 423 (Comm'r Pat. 1967), held:

The Board in its decision of February 8, 1967 held that it had not employed a new ground of rejection and pointed out its reasons for so holding. A careful review of the case fails to disclose any such clear error in the Board's action in that respect as would justify supervisory intervention. The Board's interpretation of the claims would appear to be a matter reviewable on appeal to the Courts rather than upon petition. *In re Weiss* 160 USPQ 423, 424 (Comm'r Pat. 1967).

Thus, since the panel, of this appeal, has pointed out its reason for not holding the rejection of claim 1 as a new ground of rejection, Appellants petition must be denied. Appellants' time to file an appeal to the Courts continues to run from the date of the Decision on Request for Rehearing.

## DECISION

In view of the foregoing, the Petition is DENIED.



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James P. Moore  
Acting Chief Administrative Patent Judge

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